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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,901	02/18/2004	Manfred R. Kuehnle	3483.1000-001	9060
21005	7590	09/08/2005	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			LE, HOA T	
		ART UNIT	PAPER NUMBER	
		1773		

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/780,901	KUEHNLE ET AL	
	Examiner H. T. Le	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 June 2005.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,7,8,15,21-27,34 and 36-39 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,7,8,15,21-27,34 and 36-39 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Double Patenting*

2. Claims 1-4, 7, 8, 15, 21- 27, 34, and 36-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 11, 14-20, and 27-31 of U. S. Patent No. 10/780,896. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reason. The examined claims and the conflicting claims are substantially identical except for that the conflicting claims name specific material for the first conductive materials. However, the materials that listed as the “first conducive material” read on the broad recitation “first conductive materials” of the instant claims. Therefore, the conflicting claims read on the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants argued that “the amended claims are directed to the subject matter distinguishable by the composition of the particles”; therefore, the double patenting rejection is no longer appropriate. As stated above, all the materials for the “first conductive material” as recited in the conflicting claims are “conductive material”; therefore, they read on the broadly claimed “first conductive material” of the instant claims. Therefore, the double patenting rejection still applies and thus is maintained.

***Claim Rejections - 35 USC § 112***

3. Claims 1-4, 7, 8, 15, 21- 27, 34, and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed provides support only a refracting material having a refractive index of greater than 1.8. The instant claims as amended remove such limitation and thus include a refractive index below 1.8. The claims as amended, which permit refracting materials that have refractive index equal or less than 1.8, find no support in the original specification and thus contain new matter.

4. Applicants reasoned that because aluminum oxide, the intrinsic refractive index of which is less than 1.8, is listed as the refracting material; therefore, the limitation of refractive index of larger than 1.8 has been removed to correct such error. However, the specification is predicated on the foundation that the refracting materials have a refractive index of greater than 1.8. Removing such critical element of the claimed invention generates new matter issue. In addition, the specification does not include  $\text{Al}_2\text{O}_3$  as the refracting material (see page 13). Therefore it is apparent that the error is on the  $\text{Al}_2\text{O}_3$ , not on the refractive index of the refracting material. Therefore, " $\text{Al}_2\text{O}_3$ " must be removed from the claims and the limitation "refractive index of greater than 1.8" must be reinstated in the claims in order to obviate this rejection.

5. Claims 1-4, 7, 8, 15, 21- 27, 34, and 36-39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for refracting material having a refractive index of greater than 1.8, does not reasonably provide enablement for refractive index lower than that range. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Therefore, the instant claims as amended, which fail to include such limitation, are deemed broader than the enabling scope of the disclosure.

6. Claims 8 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed has no support for a peak of absorption at a wavelength above 700 nm. Thus a wavelength at 750 nm is new matter and must be canceled.

7. In claim 38, "nylon" and "orlon" are trademarks and thus must be replaced by their generic names.

*Response to Amendment*

8. The amendment filed June 27, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The material which is not

supported by the original disclosure is as follows: the refractive index for the refracting material being less than or equal to 1.8. The removal of the element "refractive index of greater than 1.8" creates new matter as mentioned.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le  
Primary Examiner  
Art Unit 1773